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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,532	11/21/2001	John Brinkman	3992P002	3089

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EXAMINER

COULTER, KENNETH R

ART UNIT PAPER NUMBER

2141

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,532

Applicant(s)

BRINKMAN ET AL.

Examiner

Kenneth R Coulter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/10/03; 4/22/02</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 33 of U.S. Patent No. 6,740,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Independent claims 1, 19, and 37 of the present Application are highly related versions of independent claims 1, 12, and 23 of U.S. Pat. No. 6,740,803. Independent claims 1, 12, and 23 of '803 teach the processing of digitized audio signal of the guitar so that the user can play the musical instrument; claims 1, 19, and 37 of the present Application disclose an interface device, coupling method, and conversion operation (respectively) that enable the user to play the musical instrument. The differences

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between the present Application and '803 are minor differences that do not yield patentably distinct features.

Claims 13, 31, and 49 of the present Application disclose that the musical instrument is a microphone. The claims of 6,740,803 do not teach this limitation.

The human voice is often considered an instrument. A microphone is a notoriously well-known device to detect singing.

3. The Examiner notes that

claim 1 maps to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claim 19 maps to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claim 37 maps to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claims 2, 20, and 38 map to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claims 3, 21, and 39 map to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claims 4, 22, and 40 map to claims 9, 20, and 31 of U.S. Pat. No. 6,740,803;

claims 5, 23, and 41 map to claims 10, 21, and 32 of U.S. Pat. No. 6,740,803;

claims 6, 24, and 42 map to claims 2, 13, and 24 of U.S. Pat. No. 6,740,803;

claims 7, 25, and 43 map to claims 3, 14, and 25 of U.S. Pat. No. 6,740,803;

claims 8, 26, and 44 map to claims 4, 15, and 26 of U.S. Pat. No. 6,740,803;

claims 9, 27, and 45 map to claims 5, 16, and 27 of U.S. Pat. No. 6,740,803;

claims 10, 28, and 46 map to claims 6, 17, and 28 of U.S. Pat. No. 6,740,803;

claims 11, 29, and 47 map to claims 7, 18, and 29 of U.S. Pat. No. 6,740,803;

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claims 12, 30, and 48 map to claims 8, 19, and 30 of U.S. Pat. No. 6,740,803;

claims 13, 31, and 49 do not explicitly map to any claims of U.S. Pat. No.

6,740,803 (see explanation above);

claims 14, 32, and 50 map to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claims 15, 33, and 51 map to claims 1, 12, and 23 of U.S. Pat. No. 6,740,803;

claims 16, 34, and 52 map to claims 9, 20, and 31 of U.S. Pat. No. 6,740,803;

claims 17, 35, and 53 map to claims 10, 21, and 32 of U.S. Pat. No. 6,740,803;

and

claims 18, 36, and 54 map to claims 11, 22, 33 of U.S. Pat. No. 6,740,803;

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 14, 19 – 32, and 37 - 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa (U.S. Pat. No. 6,426,455) (System and Method for Teaching/Learning to Play a Musical Instrument).

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5.1 Regarding claim 1, Hasegawa discloses a system to deliver a multimedia presentation of an audio file to a computing device for display to a user that allows the user to play a musical instrument in conjunction with the multimedia presentation, the system comprising:

a server to transmit a session file to the computing device through a computer network in response to a user selecting a musical piece, the session file associated with the selected musical piece, the session file including an audio file and multimedia data such that the computing device processes the session file to present the multimedia presentation of the audio file to the user (Abstract "server 30"; Fig. 1; col. 5, line 56 – col. 6, line 2); and

an interface device connected to the computing device and the user's musical instrument, the interface device to couple the musical instrument to the computing device such that the user can play the musical instrument in conjunction with the multimedia presentation of the audio file (Abstract; Figs. 3, 4).

5.2 Per claim 2, Hasegawa teaches the system of claim 1, wherein a control panel graphical interface for the musical instrument is displayed by the computing device, the control panel graphical interface having settings that define sound characteristics for the musical instrument (Figs. 3, 4).

5.3 Regarding claim 3, Hasegawa discloses the system of claim 2, wherein the control panel graphical interface allows the user to set the sound characteristics for the

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musical instrument (Figs. 3, 4).

5.4 Per claim 4, Hasegawa teaches the system of claim 2, wherein the multimedia data of the session file sets the control panel graphical interface to pre-defined values to model the sound characteristics of the musical instrument associated with the audio file for the musical piece selected by the user (Figs. 3, 4).

5.5 Regarding claim 5, Hasegawa does not explicitly disclose the system of claim 1, wherein a track associated with the user's musical instrument is removed from the audio file of the musical piece selected by the user such that the user can play the user's musical instrument in conjunction with a multimedia presentation of the audio file that does not include the user's musical instrument.

However, this feature is inherent in Hasegawa in order for the user playing the musical instrument in Hasegawa properly learn how to play the instrument.

5.6 Per claim 6, Hasegawa teaches the system of claim 1, wherein the multimedia data of the session file causes the display of music notation associated with the audio file of the musical piece selected by the user (col. 7, lines 42 – 47 “music score”).

5.7 Regarding claim 7, Hasegawa discloses the system of claim 1, wherein the server identifies the user based upon a unique identifier stored in the interface device (col. 5, lines 47 – 50 “identification number”).

5.8 Per claim 8, Hasegawa does not explicitly teach the system of claim 7, wherein the unique identifier stored in the user's interface device is the serial number associated with the interface device.

However, implementing a device serial number as a unique identifier of a user is an inherent GUI scenario that is possibly implemented in Hasegawa but not explicitly disclosed.

5.9 Regarding claim 9, Hasegawa discloses the system of claim 7, wherein the server tailors a presentation of musical pieces to the user based upon the unique identifier (col. 5, lines 27 - 55).

5.10 Per claim 10, Hasegawa teaches the system of claim 7, wherein the interface device stores a user key associated with the interface device (col. 5, lines 27 - 55).

5.11 Regarding claim 11, Hasegawa does not explicitly disclose the system of claim 10, wherein the audio file transmitted from the server to the computing device of the user is encrypted with an audio file key associated with the audio file and the audio file key is encrypted with user key for the user and is also transmitted to the computing device.

However, the encryption/decryption of audio data is inherent in order to protect the property rights of the audio data owner.

5.12 Per claim 12, Hasegawa does not explicitly teach the system of claim 11, wherein the interface device decrypts the audio file key that is encrypted with the user key using the stored user key and transmits the decrypted audio file key to the computing device such that the computing device uses the decrypted audio file key to decrypt the audio file.

However, the encryption/decryption of audio data is inherent in order to protect the property rights of the audio data owner.

5.13 Regarding claim 13, Hasegawa does not explicitly disclose the system of claim 1, wherein the musical instrument is a microphone.

The human voice is often considered an instrument. A microphone is a notoriously well-known device to detect singing.

5.14 Per claim 14, Hasegawa teaches the system of claim 1, wherein the musical instrument is a guitar (col. 7, lines 63 – 67 “stringed instruments”).

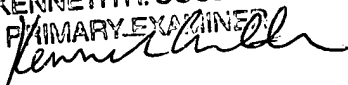
5.15 Regarding claims 19 – 32, and 37 – 50, the rejection of claims 1 – 14 under 35 USC 102(e) (paragraphs 5.1 – 5.14 above) applies fully.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER


krc